

REMARKS

Claims 1-3, 6, 8 and 10-39 are pending.

Claim Objections

To match the amendments that the Examiner states have already been made, Applicants have renumbered claims 25-38 to be claims 24-37 and have changed all references to claim 24 to claim 23.

The Examiner has suggested that the language in claims 19 and 37 be amended to recite that the most recent date should be in reference to the contact, not the dealer. Applicant has amended these claims to make this change.

Claim Rejections 35 USC § 103

The Examiner has rejected claims 1-37 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,826,552 to Grosser et al. ("Grosser"). Applicant has cancelled claims 4, 5, 7 and 9 and has amended many of the remaining claims, including all of the independent claims. As amended, this rejection is respectfully traversed and reconsideration is requested.

Preliminarily, applicants note that the Examiner has often admitted that Grosser lacks a feature that is required by one of these claims, but nevertheless has stated that the feature would have been obvious. In each case, however, the Examiner has done so without citing any prior art reference that disclosed the missing feature. In many cases, moreover, the Examiner has not even offered an explanation as to why the skilled artisan would have been motivated to have modified Grosser to have included such feature, nor is this otherwise apparent. In short, the Examiner has not supported these rejections with evidence.

Applicants also respectfully submit that the Examiner has not satisfied the requirements that are set forth in the Manual of Patent Examination Procedure for obvious-type rejections. This Manual makes clear that it is not legally sufficient to merely state that certain modifications to Grosser would have been obvious. To establish a prima facie case of obviousness, the Examiner must cite prior art that disclosed each missing feature and must explain why the skilled artisan would have been motivated to have modified Grosser to incorporate these features:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

M.P.E.P. 2142.

It is also hornbook patent law that hindsight may not be used. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." M.P.E.P. Yet, the only possible source in the record relied upon by the Examiner for concluding that these claims were obvious is applicants' disclosure. Should the Examiner instead be relying upon prior art that has not been cited, applicants would respectfully request that the Examiner provide a citation to this prior art so that applicants can have a fair chance to respond to it.

Applicants will address specific deficiencies in the Examiner's rejection.

Amended claim 1 is directed to an automated method for referring a prospective customer to a dealer. A database is queried to identify dealers with whom the prospective customer has had prior contact. Two or more dealers are identified that have had prior contacts with the prospective customer of a different type. The prospective customer is delivered information about at least one of the located dealers, giving preference to the dealer or dealers with whom the customer has had a prior contact of one of the types.

The Examiner admits that Grosser did not disclose elements in original claim 1. The Examiner nevertheless contends that Grosser taught saving information from previous searches, including values, and that it therefore was obvious to have recorded that a customer had purchased or serviced a vehicle and to put that dealer on top of the list. Applicants respectfully disagree.

First, it is well established that a generic teaching does not render all species of the generic teaching obvious. The fact that Grosser taught "saving information from previous

searches” in no rendered obvious saving every particular type of information, such as customer/dealer contact information.

Second, what amended claim 1 requires is not a species of this generic disclosure in Grosser. “Saving information from previous searches” did not describe the saving of customer contact information. Contact information is not information from a previous search.

Third, “saving information from previous searches” did not in any way suggest to “put that dealer at the top,” as stated by the Examiner. Nothing relied upon by the Examiner even remotely suggested such a concept.

Forth, merely to “put that dealer on top,” as stated by the Examiner, still does not meet the requirement of amended Claim 1. Amended claim 1 requires that a preference be given to prior contacts of a certain type. Again, nothing relied upon by the Examiner even remotely suggested such a concept.

Claims 2-3, 6, 8, and 10-19 are dependent upon claim 1 and thus are also not obvious in view of Grosser.

Amended claim 6 also requires that the prior contact to which a preference be given have been a selling relationship. The Examiner again fails to cite any prior art that suggested such a preference.

Amended claim 8 also somewhat oppositely requires that a lower preference be given to a prior contact that was a service relationship. The Examiner again fails to cite any prior art that suggested such a preference.

Amended claim 10 also requires that a second round of prompting, receiving and querying be made in connection with a different prospective customer. Following this second round, and unlike following the first round, claim 10 requires that no prior contact information be found in the database. Instead, claim 10 requires that the different prospective customer be delivered information about at least one of the dealers that are near the different prospective customer. Amended claim 10 thus delineates two tiers of automated referral preferences: First, to

a dealer that had a prior contact of a particular type, and second, to a dealer that is near the prospective customer. Nothing even remotely similar was disclosed in Grosser.

Amended claim 18 also requires that a more recent prior contact within contacts of the same type be given preference. Again, nothing of the sort was disclosed by Grosser.

Amended claim 20 is a system claim that is similar to the process recited in amended claim 1. It similarly requires a system that refers a customer to dealers based on the customer's prior contact history with the dealers and the more specific concept of giving preference to dealers with whom the customer has had prior contacts of a particular type. Again, Grosser did not disclose such a system or anything that rendered such a system obvious. For further detail, Applicants refer the Examiner to their remarks made above in connection with amended claim 1.

Claims 21-22 are dependent upon amended claim 20 and therefore are also not obvious in view of Grosser.

Amended claim 23 is directed to an automated method for referring a prospective customer to a dealer. A database is queried to identify dealers with whom the prospective customer has had prior contacts. If the database contains information about any such prior contacts, information about at least one of the dealers with whom the prospective customer had a prior contact is reported. If the database lacks any such prior contact information, information about at least one of the dealers that are near the perspective customer is instead reported. Thus, claim 23 establishes a two-tier system of automated preferences: First for dealers that have had a prior contact with the prospective customer; and second for dealers that are near the prospective customer. Again, Grosser did not disclose anything like claim 23.

Claims 24-30 are dependent upon claim 23 and thus were also not obvious in view of Grosser.

Claim 27 also requires that preference be given to dealers that have had a particular type of prior contact with a customer. This further distinguishes this claim from Grosser for the reasons stated above in connection with claim 1.

Claim 36 also requires that preference be given to dealers that have had the most recent contact with the prospective customer. This further distinguishes this claim from Grosser, who again failed to disclose such a feature.

New Claims

New claims 38 and 39 are broadened versions of original claims 1 and 10, respectfully, and are similarly squarely supported by the original specification. *See, e.g.*, paragraphs [0013] - [0018], [0039] - [051], FIG. 2. Thus, no new matter has been added. These new claims are also not obvious in view of Grosser for the reasons stated above in connection with claims 1, 10 and 23.

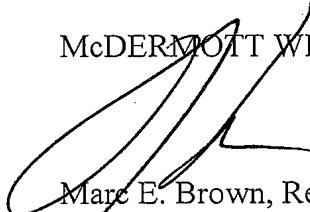
Conclusion

For the foregoing reasons, Applicants respectfully submit that this Amendment places this application in condition for allowance and early notice of the same is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 501946 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Marc E. Brown, Registration No. 28,590

2049 Century Park East, 34th Floor
Los Angeles, CA 90067
Phone: (310) 277-4110
Facsimile: (310) 277-4730
Date: January 2, 2007

**Please recognize our Customer No. 33401
as our correspondence address.**